

Appl. No. : 09/037,945
Filed : March 10, 1998

The Examiner continues to reject each of the pending claims as obvious under 35 U.S.C. §103(a) over German Patent DD 266,885 (Germany '885), either alone (Claims 1, 2, 4, 8, 9, 14, 16 and 17) or in combination with secondary references (Claims 3, 11-12).

Applicants respectfully traverse the rejections for the same reasons set forth in prior remarks, filed March 13, 2000 and April 17, 2000. Accordingly, Applicants reiterate and incorporate by reference remarks made in those previous responses.

As previously noted, the crux of the matter is whether Germany '885 renders the claims obvious. In particular, Germany '885 taught a wet oxidation followed by a dry oxidation. The Examiner states that it would be obvious to *omit* the wet oxidation of Germany '885, thereby teaching the invention of independent Claim 1, for example.

The Examiner states that "Applicant appears to argue that the reference must disclose elimination of the first step." Office Action at p.3. Applicants do not so argue. Rather, Applicants simply point out that the Examiner must point to a *suggestion* in the prior art to perform the modification of Germany '885 that the Examiner asserts, namely the omission of the first step (wet oxidation).

Initially, it should be pointed out that the Examiner acknowledges that modification of Germany '885 is required to construct a rejection, since the Examiner has provided an obviousness rejection and not an anticipation rejection. Since Germany '885 clearly taught a two-step oxidation, including a first step of wet oxidation and a second step of dry oxidation, modification of this teaching is required to arrive at Applicants' claimed invention. Each of Applicants' pending claims exclude the possibility of wet oxidation, as explained in previous responses.

As an ostensible suggestion to perform this modification, the Examiner states that:

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the reference suggests elimination of the step [of wet oxidation] in disclosing the function of the step *in the event* that the disclosed function is not desired to be obtained. It is clear from the teachings of the reference that a field oxide *could be* produced by the second step alone although the process would be longer in duration.

Office Action at p. 3 (emphasis added).

Applicants submit that the Examiner has applied the wrong standard for determining obviousness. The question is not whether the prior art *could be* modified to arrive at Applicants' invention; rather, the question is whether the prior art *suggested* this modification. This means that the prior art must teach not only technical feasibility, but also *desirability* of the modification. "The mere fact that the prior art *could be* so modified would not have made the modification obvious unless the prior art suggested the *desirability* of the modification." *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (emphasis added). The Examiner has not shown any indication from Germany '885 or the other references of record that omission of the wet oxidation step might be desirable.

Furthermore, Germany '885 not only fails to give positive reasons to omit the wet oxidation step, but the skilled artisan would have considered the first wet oxidation of Germany '885 advantageous for obtaining speed, as acknowledged by the Examiner. Reading Germany '885, the skilled artisan would have been given no reason to omit the wet oxidation, since Germany '885 discloses no advantages in such an omission, only the disadvantage of losing speed. "In determining whether such a suggestion can fairly be gleaned from the prior art, the *full field* of the invention must be considered for the person of ordinary skill is charged with knowledge of the entire body of technological literature, *including that which might lead away* from the claimed invention." *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, 1531-32 (Fed. Cir. 1988) (emphasis added).

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The fact that the Examiner simply assumes desirability of the modification, rather than showing that desirability from the prior art, is a sure sign that the Examiner has inadvertently applied hindsight in view of Applicants' own invention. Rather than giving a reason from the prior art to omit the first wet oxidation of Germany '885, the Examiner effectively states that *if* the skilled artisan did not need speed, *then* the skilled artisan could omit the wet oxidation step and perform only a dry oxidation. But the only source of record for this omission is Applicants' own application and claims. "The suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness." In re Rouffet, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998).

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'"

In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (*quoting* W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)).

Each of the Examiner's rejections depends upon the modification of Germany '885 to omit the expressly taught wet oxidation. Because the art of record includes no indication of the desirability in the prior art of performing this modification, Applicants submit that the art of record fails to render the claims obvious.

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CONCLUSIONS

In view of the foregoing remarks, Applicants submit that the application is in condition for allowance and respectfully request reconsideration of the claims. If, however, the Examiner feels some issue remains that can be addressed by Examiner's Amendment, the Examiner is cordially invited to call the undersigned for authorization.

Respectfully submitted,

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